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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/856,846 05/15/97 BRYAN

V P1147USA

QM12/0818

EXAMINER

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NGUYEN, T

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

08/18/99

*14*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. <b>08/856,846</b>	Applicant(s) <b>BRYAN et al.</b>
Examiner <b>Tram Nguyen</b>	Group Art Unit <b>3738</b>

Responsive to communication(s) filed on Jun 4, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 2-6 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 2-6 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

***Continued Prosecution Application***

1. The request filed on June 4, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/856,846 is acceptable and a CPA has been established. An action on the CPA follows.

***Terminal Disclaimer***

2. The terminal disclaimer filed on June 4, 1999 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,674,296 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Specification***

3. The disclosure is objected to because of the following informalities: on page 10, 3rd full paragraph, in line 2, after "annular gasket" applicant should replace "24" with -- 22 -- and in line 3, after "damaged nucleus" applicant should replace "22" with -- 24 --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the following reasons:

6. Claims 3 and 4 recite the limitation "the nucleus body" in lines 2, respectively. There is insufficient antecedent basis for this limitation in the claims. Did applicant intend to recite "nuclear body" instead? If so, correction is required.

7. Claim 6 recites the limitation "the confronting concave surfaces" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 U.S.C. § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller '432 in view of Buettner-Janz et al. '766.

With respect to claims 2 and 6, Keller discloses a vertebral disc endoprosthesis substantially as claimed (see col. 3, lines 29-42, col. 4, line 57 to col. 5, line 2, and Figure 1) wherein a solid relatively resilient convex nuclear body (8) made of synthetic material is held in sliding position between two plates (5) having concave inner surfaces (7). However, Keller fails to disclose that the plates also include convex outer surfaces. Buettner-Janz et al. teaches in Figures 1 and 3 plates for holding a nuclear body for forming a vertebral disc endoprosthesis, the plates having concave inner surfaces and convex outer surfaces. It would have been an obvious matter of design choice to have made the plates of Keller with convex outer surfaces, as taught by Buettner-Janz et al., since applicant has not disclosed that these particular characteristics unexpectedly solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well as disclosed by Keller.

11. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller '432 in view of Buettner-Janz et al. '766, as applied to claims 2 and 6 above, and further in view of Bainville et al. '294.

a. With respect to claim 3, the modified Keller does not show a gasket surrounding the nucleus body. Bainville et al. shows an intervertebral disk prosthesis comprising a compression cushion enveloped between two metal half-envelopes and further comprising a membrane or diaphragm surrounding the cushion in order to insure a seal between the cushion and the

environment. It would have been obvious to one of ordinary skill in the art to add a membrane or diaphragm (i.e., a gasket) to surround Keller's modified nucleus body in view of Bainville et al. in order to protect against expulsion of the nucleus body.

- b. For claim 4, refer to Bainville et al., col. 4, lines 45-53.
- c. For claim 5, refer to Keller, Figure 1.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shima '029 also shows various features of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tram Nguyen whose telephone number is (703) 308-0804. The examiner can normally be reached on Monday - Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached at (703) 308-2672. The fax phone number for this group is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceedings should be directed to the group receptionist whose telephone number is (703) 308-0858.

*Tan*  
TAN  
August 13, 1999

  
David H. Willse  
Primary Examiner